

68

Notice of Allowability	Application No.	Applicant(s)	
	10/765,425	LAI ET AL.	
	Examiner	Art Unit	
	Kuo-Liang Peng	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/21/04 RCE.
2. ☒ The allowed claim(s) is/are 24 and 26.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

52

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on December 21, 2004 has been entered.

2. It is noted that none of the references cited in the international search report teaches or fairly suggest a method of producing an ophthalmic device utilizing the specific polymeric composition set forth in the present invention. Since there is no corresponding PTO 1449 form provided, there will be no initialed PTO 1449 form to be sent to Applicants. Instead, the references in the international search report are included in a PTO 892 form.

Examiner's Amendment

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as

Art Unit: 1712

provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In the specification, after the title, replace "This application is a divisional application of prior Application Serial No. 10/004,418 filed November 2, 2001." with -- This application is a divisional application of prior Application Serial No. 10/004,418 filed November 2, 2001, now U.S. Patent No. 6,864,341. --.

Allowable Subject Matter

4. Claims 24 and 26 are allowed.

5. The following is an examiner's statement of reasons for allowance:

The present claims are allowable over the closest references for at least the following reason(s): Okawa (US 5 223 596), Cekada (US 3 624 190) and Lai (US 5 034 461).

Okawa does not teach or fairly suggest a polydiorganosiloxane having $R_2R_3SiO_{2/2}$ units, where R_2 is independently a C_{1-10} alkyl, C_{1-10} fluoroalkyl or a C_{2-20} alkyl-fluoroalkyl group and R_3 is independently a C_{6-30} aromatic group, e.g., a diphenylsiloxane-dimethylsiloxane copolymer. Furthermore, in the instant claims,

Art Unit: 1712

the number of $R_2R_3SiO_{2/2}$ units must be a natural number greater than 4. In addition, Okawa does not teach or fairly suggest a method of producing an ophthalmic device using a polymeric composition produced from the polydiorganosiloxane.

Cekada does not teach or fairly suggest that the polydiorganosiloxanes being end-capped with hydroxyalkyl groups or aminoalkyl groups or having methylphenylsiloxane units. In addition, Okawa does not teach or fairly suggest a method of producing an ophthalmic device using a polymeric composition produced from the polydiorganosiloxane.

Lai discloses a polydiorganosiloxane end-capped with hydroxyalkyl groups represented by formula c) (col. 3, line 44 to col. 4, line 50, col. 6, lines 2-7 and 31-43). However, Lai does not teach or fairly suggest a method of producing an ophthalmic device using a polymeric composition produced from the specific polydiorganosiloxane set forth in the present invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Art Unit: 1712

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
April 29, 2005


Kuo-Liang Peng
Primary Examiner
Art Unit 1712